

REMARKS

Summary

Two competing utility applications have been filed with claims covering all of the subject matter of, and claiming priority from, the same provisional application, U.S. Application No. 60/448,153 ("the '153 provisional application"). The '153 provisional application was filed February 19, 2003, and the inventors were designated to be Paul David Manos and Gregory James Caton.

One of the two competing utility applications is the above-identified application, which was filed February 19, 2004, and designates solely Gregory James Caton as the inventor ("the instant ('405) application"). The other application, which was filed June 27, 2003 and was assigned U.S. Application No. 10/606,946, designates solely Paul David Manos as the inventor ("the '946 application"). The '946 application has now issued as U.S. Patent No. 7,264,847.

Applicant of the instant application, Gregory James Caton, submits that he was unlawfully not designated as an inventor on the '946 application. Therefore, to protect the rights of the Applicant, the instant application was filed on February 19, 2004.

Applicant further submits that he is lawfully the sole, and therefore the first, inventor of the invention claimed in the instant application and that any contribution allegedly made by Paul David Manos to the invention claimed therein was disclosed in PCT International Application No. PCT/US01/45615, entitled 2, 4-HEXADIENOIC ACID AND DERIVATIVES AS CORROSION INHIBITORS, published May 30, 2002, as WO 2002/042523. Therefore, any contribution that allegedly could have been made by Paul David

Manos to the invention disclosed in Provisional Application No. 60/448,153 was in the prior art when the '153 provisional application was filed on February 19, 2003. This information was placed on record with the U.S. Patent and Trademark Office in a Letter submitted July 14, 2004.

Proof of Facts

The ownership of the '405 application and the '946 application (now U.S. Patent No. 7,264,847) has recently been the subject of litigation in:

INTELLECTUAL CONCEPTS, L.L.C. and  
GLOBAL PRESERVATIVES, L.L.C.

VS. NO. 2004-2675 DIV. "G"

WONDERS OF WATER. L.L.C.  
HERBOLOGICS, LTD. AND  
WILLIAMS FOOD GROUP, L.L.C.

in the 14<sup>th</sup> Judicial District Court, Parish of Calcasieu, State of Louisiana. In a Judgment dated August 28, 2007 (copy attached), District Judge G. Michael Canaday stated as follows:

IT IS ORDERED that INTELLECTUAL CONCEPTS, LLC is the owner of any patent issued on a formula described alternatively, as "lower alkyl carboxylic acid moieties as organoleptic stabilizers and preservatives of food and beverages and for preventing oxidative corrosion of metals" or "lower alkyl carboxylic acid moieties for preventing oxidative corrosion of metals and organoleptic stabilizer for food and beverages", whether such patent be issued as a result of U.S. Patent Application No. 10/606,946 or U.S. Patent Application No. 10/782,405.

During this bench trial on the issue of ownership, Judge Canaday had to consider the question of inventorship. In his Findings of Fact and Conclusions of Law dated August 17, 2007

(copy attached), Judge Canaday acknowledged in Conclusions of Law No. 17:

17.

This court cannot determine inventorship. 35 U.S.C. §256 gives that task to a Federal District Court after a patent is issued. However, ownership, being a State issue, allows a State Court to look at elements of inventorship when no patent has yet been issued, to determine a starting point for ownership.

The following Findings of Fact by Judge Canaday (excerpted from the attached document), which are related to *inventorship* and, thus, to *ownership*, are particularly relevant to, and support, the Applicants' assertions above:

4.

The USPTO issued Patent Number 6,833,087 (the '087 patent), from the '799 application on December 21, 2004. The '087 patent on its face shows Dr. Robert Beck and Paul David Manos as inventors and Wonders of Water, LLC and Intellectual Concepts, LLC as assignees, or owners. Robert Bentley, Jr. is not shown as an owner.

5.

The invention of the '087 patent was first disclosed publicly in the corresponding International Application No. PCT/US01/45615 ("the PCT application"), also filed on October 25, 2001 and entitled 2,4-HEXADIENOIC ACID AND DERIVATIVES AS CORROSION INHIBITORS. The PCT application was published May 30, 2002, as WO 02/042523. The date on which its contents became part of the public domain.

When Paul David Manos came to Lake Charles to work with Greg Caton on RP 20 improvements, the composition of RP 20 was in the public domain.

Intellectual Concepts, LLC owns the rights to the food and beverage claims of Patent No. 6,833,087 and the rights of Gregory James Caton ("Greg Caton") who improved the patented formula by the addition of the preservative chemicals he had a history of using.

11.

Although Paul David Manos was around at the time of the experiments, either late 2002 or 2003, his sole contribution was the formulation of RP 20, which came into the public domain on May 30, 2002, when the PCT application was published as WO 02/042523.

12.

Greg Caton determined that a specific combination of potassium sorbate, methylelulose [sic], sodium benzoate and sodium propionate will not degrade and will stay in solution indefinitely, and for which we now know is still effective for at least three (3) years.

16.

At Paul David Manos' request, Greg Caton allowed Paul David Manos to be listed as co-inventor. Greg Caton was not aware of the rights that go with inventorship at the time of filing of the application.

18.

Unknown to Greg Caton, Paul David Manos had Alston & Bird file U.S. Patent Application No. 10/606,946 ("the '946 application"), which claims priority from the '153 provisional, listing Paul David Manos as the sole inventor. The '946 application was filed on June 26, 2003.

21.

In an assignment dated December 22, 2003, Greg Caton transferred to Intellectual Concepts, LLC, his interest in the '153 provisional, the invention, and in any future patent applications based on the substance of the '153 provisional. The full utility application claiming priority from the '153 provisional and designating Greg Caton as the inventor was filed on Feb. 19, 2004 as U.S. Application No. 10/782,405 ("the '405 application").

22.

Paul David Manos has acknowledged in his testimony in a deposition taken March 16, 2007 that the idea to add the sodium benzoate and the sodium propionate was

Greg Caton's. [See attached deposition transcript, e.g., at p. 109, lines 10-23 and p. 113, lines 3-20 (questioning by Greg Caton)]

23.

The concept of the invention claimed in the '153 provisional, the '946 application, and the '405 application is the addition of the lower alkyl carboxylic acid moieties to the product covered by the '087 patent, in order to prevent the patented product from degrading and/or spoiling. The evidence reflects that Greg Caton both conceived the idea of how to improve the RP 20 product, and then developed the method of making the new chemical formulation. There is no evidence that suggests Paul David Manos conceived the idea, or developed the method, of making the new chemical formula described and claimed in the '153 provisional, the '946 application and the '405 application.

24.

The Court has considered the testimony of Greg Caton and Paul David Manos as to what is the claimed invention in the '153 provisional, the '946 application and the '405 application, and the Court finds that Greg Caton is able to describe the invention with particularity whereas Paul David Manos did not describe the claimed invention, and does not appear to know all of its chemical components or how it works.

25.

Greg Caton's testimony is corroborated by the testimony of Paul David Manos in his deposition and the receipts reflecting Greg Caton's long use of sodium benzoate and sodium propionate.

28.

The contribution of Paul David Manos to the claimed invention is to bring the Wonders of Water, LLC patented product to Greg Caton.

29.

Since Paul David Manos neither conceived of the idea to improve RP 20, nor developed the new formula or

the process to manufacture the new formula, he can have no rights in any patent to be issued for a chemical composition described in the '153 provisional.

34.

The conclusion of this analysis is that Intellectual Concepts, LLC is the rightful owner of any patent issued on a formula described, alternatively, as "lower alkyl carboxylic acid moieties as organoleptic stabilizers and preservatives of food and beverages and for preventing oxidative corrosion of metals" or "lower alkyl carboxylic acid moieties for preventing oxidative corrosion of metals and organoleptic stabilizer for food and beverages", whether such patent be issued as a result of the '946 application or the '405 application. A judgment to this effect will be signed when presented.

#### Suggestion of Interference

Based on the facts presented above and for the sake of equity, Applicant respectfully requests that the Commissioner declare an Interference between the instant ('405) application and U.S. Application No. 10/606,946 (issued on September 4, 2007 as U.S. Patent No. 7,264,847, "the '847 patent") or take other action appropriate to the facts herein.

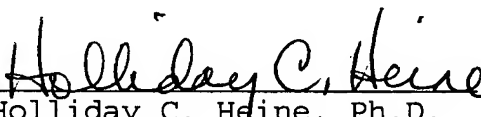
Applicant has amended the claims of the instant ('405) application herein so as to read directly on the claims as allowed in the '946 application and issued in the '847 patent. As the specifications of the '153 provisional, the '946 application and the '405 application are essentially identical, these amendments are fully supported in the application as filed and no new matter has been added. Applicant points out that claim 27 as amended herein does not now read exactly as claim 27 in the '405 application as allowed. A term deleted in the '405 application, apparently by mistake, has been retained herein.

Applicant submits that Paul David Manos, by his own deposition testimony, has admitted that the only part of the invention of the '153 provisional, the '946 application and the '405 application not within the prior art, the idea of adding the sodium benzoate and sodium propionate to the product covered by the prior art '087 patent, was contributed by Gregory James Caton and not by him. As a consequence, Gregory James Caton is lawfully the only inventor, and, therefore, the first inventor, of the invention of the '153 provisional, as claimed in the '946 application and the '405 application.

The Examiner is encouraged to telephone the undersigned attorney with any questions concerning this Petition.

Respectfully submitted,

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